

REMARKS

The claimed invention is directed to a method for treating glaucoma using the compounds of the formula set forth in claim 1 and having R as a substituted heteroaryl radical, wherein the substituent is selected from the group consisting of halogen, trifluoromethyl, COR¹, COCF₃, SO₂NR¹, NO₂ and CN, wherein R¹ is hydrogen or a lower alkyl radical having up to six carbon atoms.

The Examiner has rejected Claims 1 and 3 through 6 under 35 USC 103(a), as being unpatentable over Stjernchantz (the “369 Patent”) in view of Woodward (the “329” Patent.) The Examiner argues that the “369 Patent” “differs from the claimed invention in the substituted heteroaryl at the R position.” But the Examiner points out that the “329” Patent teaches prostaglandin compounds for treating glaucoma “with R being a cyclic moiety having 5 to 6 carbon atoms”. The “329 Patent” also teaches that the cyclic moiety may be aryl, alone, or as part of an aralkyl group and such definition indicates that the aryl ring may be substituted. Thus, the Examiner concludes that “(i)t would have been obvious to a person skilled in the art to add substitutes to an aryl ring.”

First, the “329 Patent” teaches prostaglandin-like compounds not prostaglandins. (The ring structure in this patent reference is an oxabicyclo, while the prostaglandin ring structure is cyclopentyl.) Thus, applicants believe that it is not obvious to take the substituents from a compound that is not a prostaglandin and apply them to a prostaglandin for the purpose of treating glaucoma. Also, the R_3 group which corresponds to the R group of the present claims is preferably a cycloalkyl or benzyl, most preferably cyclohexyl. Even though the Examiner points out that the R_3 group may be aryl, e.g. aralkyl, i.e. a radical in which an aryl group is substituted for an alkyl H atom, there is no specific indication that aralkyl substituted compounds of the “329 Patent” are effective for treating glaucoma. Nevertheless, the applicants, without prejudice and solely to advance the prosecution of this application, have amended the claims to delete reference to the alkylsubstituted R groups of the claimed invention. The claims are now limited to the specific substituents on the heteroaryl radical, set forth in original claim 2, i.e. halogen, trifluoromethyl, COR^1 , $COCF_3$, SO_2NR^1 , NO_2 and CN, wherein R^1 is hydrogen or a lower alkyl radical having up to six carbon Atoms. It should be pointed out that none of these substituents are suggested by the “329 Patent”.

Thus, the claims, as now amended, are clearly patentable over the combination of the “393 Patent and the “329 Patent.”

The Examiner is requested to withdraw her rejection and pass the amended claims to issue.

Docket No. 17120FWCCON6 (AP) 8
Serial No. 10/621,195

Please use Deposit Account 01-0885 for fees related to this submission.

Respectfully submitted,

Date: July 10, 2008

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